

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 41, 42, 44-47, 50, 51, 53, 54, 60, 63-72, 75-78, 80 and 81 are pending in the application, with claims 41, 63, 75 and 78 being the independent claims. Claims 1, 5-7, 9, 13, 14, 16, 18, 21, 25-28, 30, 32-40, 57, 79 and 82-93 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 46, 47, 50, 53, 54, 60 and 65 are sought to be amended. Claims 46, 47, 53 and 54 have been amended, in part, to remove non-elected subject matter. Dependent claim 50 has been amended to remove limitations made in claim 41. Dependent claim 60 has been amended to change its dependency from canceled claim 57 to claim 54. Claim 65 has been amended to remove Trademarks. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Restriction Requirement

A. Rejoin Claims into Group I

Applicants note with appreciation that the Examiner has rejoined claims 46, 50, 51, 53, 54, 57 and 60 into Group I for examination. (Office Action, page 2, lines 4-6).

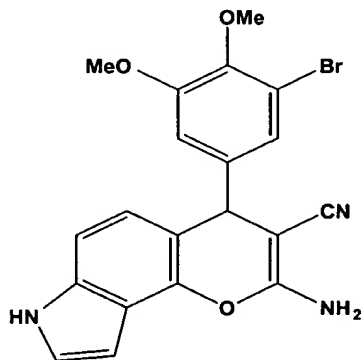
B. Revised Restriction Requirement

Applicants note the Examiner has revised the restriction requirement. The Examiner is of the opinion that:

However, the restriction requirement of group I is revised below such that: only R₂ and R₃ on the phenyl moiety of the ring core of formula II in claim 6 and all other claim drawn to a compound of formula II, form a pyrrole ring. All other radicals other than X that can equal to or result in a moiety containing a heteroaryl or heterocyclic moiety are restricted out. Also, for claim 1 and all other claims drawn to compounds of formula I, the B ring is an indolo ring where the N of the indolo ring system is separated by 4 carbons in the ring system from the X moiety.

(Office Action, page 2, lines 6-13). Applicants respectfully traverse the revised restriction requirement.

In the Reply to Requirement for Election of Species dated April 16, 2001, Applicants elected the species 2-amino-3-cyano-4-(3-bromo-4,5-dimethoxyphenyl)-4H-indolo[4,5-b]pyran having the following formula:



A pyrrole ring is formed in the above structure when R₁ and R₂ of formula II are taken together, not R₂ and R₃. In addition, Applicants note that the position of the nitrogen

atom in the above structure is such that the elected species is a 4H-indolo[4,5-b]pyran. Applicants are entitled to prosecute claims that cover the elected species. Therefore, Applicants respectfully submit the revised restriction requirement is improper and request that it be withdrawn or modified accordingly.

II. First Objection to Claims

Claims 92 and 93

The Examiner has objected to claims 92 and 93. The Examiner states that: "Applicant is advised that should claim 75 be found allowable, claim 92 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate thereof." (Office Action, page 2, lines 15-16). The Examiner also states that: "Applicant is advised that should claim 75 be found allowable, claim 93 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate thereof." (Office Action, page 3, lines 1-2). Applicants respectfully disagree with Examiner's analysis and conclusions.

However, solely to expedite prosecution and not in acquiescence to this objection, claims 92 and 93 have been canceled. Applicants respectfully submit the objections to claims 92 and 93 have been rendered moot and request that they be withdrawn.

III. First Rejection under 35 U.S.C. § 112, first paragraph

A. Method Claim 27

Claim 27 has been rejected under 35 U.S.C. § 112, first paragraph because the specification allegedly does not enable any one skilled in the art to which it pertains, to make and use the invention commensurate in scope with the claims. (*See Office Action*, page 3, line 13 through page 5, line 2). Applicants respectfully traverse this rejection.

However, solely to expedite prosecution and not in acquiescence to this rejection, claim 27 has been canceled. Applicants submit the rejection to this claim has been rendered moot and request that it be withdrawn.

B. Method Claims 4, 6, 7, 9, 13 and 21

Claims 4, 6, 7, 9, 13 and 21 have been rejected under 35 U.S.C. § 112, first paragraph because the specification allegedly does not enable any one skilled in the art to which it pertains, to make and use the invention commensurate in scope with the claims. (*See Office Action*, page 5, line 9, through page 7, line 13). Applicants respectfully traverse this rejection.

However, solely to expedite prosecution and not in acquiescence to this rejection, claims 4, 6, 7, 9, 13 and 21 have been canceled. Applicants submit the rejection to these claims has been rendered moot and request that it be withdrawn.

C. *Composition Claims 50, 51, 53, 54, 57 and 60*

Claims 50, 51, 53, 54, 57 and 60 have been rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable any one skilled in the art to which it pertains, to make and use the invention commensurate in scope with the claims. (See Office Action, page 5, line 9, through page 7, line 13). Applicants respectfully traverse this rejection.

The Examiner is of the opinion that:

. . . the specification, does not provide enablement for R R10-R14 equal to all heteroarylalkyl, heteroarylalkenyl, heterocyclic or heteroarylalkynyl or heterocycloalkyl groups in claim 53 and for R1-R4 equal to all heteroarylalkyl, heteroarylalkenyl, heterocyclic, heteroarylalkynyl or heterocycloalkyl groups as claimed in claim 6, R10-R14 in claim 16 equal to all heteroarylalkyl, heteroarylalkenyl, heterocyclic, heteroarylalkynyl or heterocycloalkyl groups or R10 and R11 or R11 and R12 coming together to from all heteroaryl or heterocyclic groups, wherein in claim 9 and 18 R can equal all heterocycloalkyl, heterocyclic or heteroaryl groups, or in claim 46, R1-R4 independently equal to all heteroarylalkyl, heteroarylalkenyl, heterocyclic or heteroarylalkynyl or heterocycloalkyl groups, and in claim 54, R equal to all heteroarylalkyl, heteroarylalkenyl, heterocyclic or heteroarylalkynyl or heterocycloalkyl groups.

(Office Action, page 5, lines 10-21). Applicants respectfully disagree.

However, solely to expedite prosecution and not in acquiescence to this rejection, the claims have been amended so they no longer recite the terms cited by the Examiner. Withdrawal of the rejection is respectfully requested.

IV. First Rejection under 35 U.S.C. § 112, second paragraph

Method Claim 33

Claim 33 has been rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. (Office Action, page 7, lines 17-19). Applicants respectfully traverse this rejection.

The Examiner is of the opinion that: "[i]n claim 33, lines 7-8, page 2 of the amendment at paper 18/D, the terms 'Herceptin ®', and 'Rituxan ®' are indefinite because they are trademarks." Applicants respectfully disagree.

However, solely to expedite prosecution and not in acquiescence to this rejection, claim 33 has been canceled. Applicants submit the rejection to claim 33 has been rendered moot and request that it be withdrawn.

V. Second Rejection under 35 U.S.C. § 112, first paragraph

Method Claim 28

Claim 28 has been rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable any one skilled in the art to which it pertains, to make and use the invention commensurate in scope with the claims. (*See* Office Action, page 8,

line 6, through page 9, line 18). (*See also* Office Action, page 14, line 11, through page 15, line 9). Applicants respectfully traverse this rejection.

However, solely to expedite prosecution and not in acquiescence to this rejection, claim 28 has been canceled. Applicants submit the rejection to this claim has been rendered moot and request that it be withdrawn.

VI. Second Objection to Claims

Claims 41 and 66-72

Claim 41 has been objected to under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 66. (Office Action, page 9, lines 19-20). Similar objections were made to claims 66-72. (*See* Office Action, page 10, line 3, through page 11, line 15).

These objections are summarized in the following table.

Claim Objected To:	In View of Claim:
41	66
66	67
67	66
68	69
69	68
70	69
71	41
72	41

Claim 41 is directed to a pharmaceutical composition. Claims 66, 68, 71 and 72 depend from claim 41. In normal claiming fashion, each of claims 66-72 adds significantly different, substantial limitations upon the subject matter of the respective claim from which each depends.

The Examiner is of the opinion that: "[l]imitations regarding the excipient or carrier in a pharmaceutical composition do not substantially limit the claim, since such limitations add no patentable weight to the claim." (Office Action, page 15, lines 13-15). Applicants respectfully disagree with Examiner's analysis and conclusions.

Applicants submit that each dependent claim adds limitations, thus giving each claim a different scope. Claim 66 has a different scope than claim 41 because it lists specific species of excipients or carriers. Because the scope of claim 66 is different than claim 41, they are not substantially duplicate claims. Likewise, claims 67-72 each add substantial limitations that change the scope of each claim. Because the scope of each claim is different than the claim from which it depends, claims 41 and 66-72 are not substantially duplicate claims. Moreover, the Examiner has not cited any prior art documents or established a rationale to support a *prima facie* case of unpatentability. Therefore, Applicants respectfully submit that the objections are improper and request that they be withdrawn.

VII. Third Rejection under 35 U.S.C. § 112, first paragraph

Method Claims 1, 5, 26 and 79

Claims 1, 5, 26 and 79 have been rejected under 35 U.S.C. § 112, first paragraph, because the specification allegedly does not enable any one skilled in the art to which it pertains, to make and use the invention commensurate in scope with the claims. (*See* Office Action, page 11, line 22, through page 13, line 10). (*See also* page 15, line 17, through page 16, line 20). Applicants respectfully traverse this rejection.

However, solely to expedite prosecution and not in acquiescence to this rejection, claims 1, 5, 26 and 79 have been canceled. Applicants submit the rejection to these claims has been rendered moot and request that it be withdrawn.

VIII. Second Rejection under 35 U.S.C. § 112, second paragraph

A. Method Claims 1, 5, 26, 27, 30, 32, 79 and 84-90

Claims 1, 5, 26, 27, 30, 32, 79 and 84-90 have been rejected under 35 U.S.C. § 112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. (Office Action, page 13, lines 14-16). Applicants respectfully traverse this rejection.

However, solely to expedite prosecution and not in acquiescence to this rejection, claims 1, 5, 26, 27, 30, 32, 79 and 84-90 have been canceled. Applicants submit the rejection to these claims has been rendered moot and request that it be withdrawn.

B. Composition Claims 64 and 65

1. Claim 64

Claim 64 has been rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. (Office Action, page 13, lines 14-16). Applicants respectfully traverse this rejection.

The Examiner is of the opinion that: "[i]n claim 64, lines 2-3, page 131, the term 'cancer chemotherapeutic agent, or a pharmaceutically acceptable salt of said agent' is indefinite. Which cancer chemotherapeutic agent or salt thereof is the applicant claiming?" (Office Action, page 14, lines 5-7). Applicants respectfully disagree.

The Examiner is also of the opinion that:

The applicant has also traversed this rejection, asserting that there is no statutory requirement that applicants list each and every member of a genus within a claim. However, the examiner notes that the applicant has not even listed one example in the claim of what a cancer chemotherapeutic agent would be in claim 64. So it is unclear as to what agents are being claimed. If it is unclear as to which agents are being claimed, certainly it would be unclear as to which pharmaceutically acceptable salts of these agents are being claimed.

(Office Action, page 17, line 18, through page 18, line 2). Applicants respectfully disagree.

The phrase appearing in claim 64 is "a known cancer chemotherapeutic agent, or a pharmaceutically acceptable salt of said agent." The phrase has support in the specification at page 38, line 27, through page 39, line 12, where a listing of chemotherapeutic agents is given. The phrase is also well known to those of ordinary skill in the art. *See, e.g.*, the listing for "Antineoplastics," PDR, page 206 (Document AT17). The meaning of the phrase "a pharmaceutically acceptable salt" is well known to those of ordinary skill in the art and is also fully described in the specification (*see* page 44, line 25, through page 45, line 3). Therefore, the term "cancer chemotherapeutic agent, or a pharmaceutically acceptable salt of said agent" is *not* indefinite.

Furthermore, the Examiner has provided no evidentiary support for an assertion that the phrase "[a known] cancer chemotherapeutic agent, or a pharmaceutically acceptable salt of said agent" would *not* be readily understood by those of ordinary skill in the art at the time the invention was made. Therefore, the Examiner has *not* established a *prima facie* case that claim 64 is indefinite under 35 U.S.C. § 112, second paragraph.

For the reasons listed above, Applicants respectfully submit that claim 64 is *not* indefinite under 35 U.S.C. § 112, second paragraph. Applicants submit the rejection is improper and request that it be withdrawn.

2. Claim 65

Claim 65 has been rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. (Office Action, page 13, lines 14-16). Applicants respectfully traverse this rejection.

The Examiner is of the opinion that: "[i]n claim 65, lines 7-8, page 3 of the amendment at paper 18/D, the terms 'Herceptin ®', and 'Rituxan ®' are indefinite because they are trademarks." (Office Action, page 14, lines 8-9). Applicants respectfully disagree.

However, solely to expedite prosecution and not in acquiescence to this rejection, claim 65 has been amended to remove the Trademarks. The generic names trastuzumab and rituximab are used in place of the Trademarks, Herceptin® and Rituxan®, respectively. Applicants submit the rejection to claim 65 has been rendered moot and request that it be withdrawn.

IX. Third Claim Objections

Claims 25, 34-38, 40, 41, 66-72, 76, 77, 82, 83 and 91 have been objected to because they are based on a rejected claim and/or are duplicates of another claim. (Office Action, page 18, lines 13-14). Applicants respectfully disagree.

Claims 25, 34-38, 40, 82, 83 and 91 have been canceled. Applicants believe all other claim objections/rejections have been overcome or rendered moot. Applicants respectfully

submit that the objection to claims 41, 66-72, 76 and 77 is improper and request that it be withdrawn.

X. *Allowable Subject Matter*

Applicants note, with appreciation, that claims 42, 44, 45, 63-65, 75, 78, 80 and 81 are allowable. (Office Action, page 18, lines 15-16).

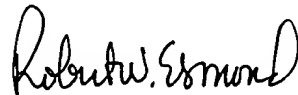
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: Oct. 17, 2003

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600